



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,504	04/02/2001	Charles M. Link II	BS01-020	7521

36192 7590 11/03/2004

CANTOR COLBURN LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

EXAMINER

FERGUSON, KEITH

ART UNIT	PAPER NUMBER
----------	--------------

2683

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/822,504	Applicant(s) LINK II ET AL.	
	Examiner Keith T. Ferguson	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
 4a) Of the above claim(s) 15-18 and 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-14 and 19-26 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 1 the order of the method is confusing. For example, step (d) transmitting the selected message to the wireless device; (e) storing messages to be transmitted to wireless communication devices in a pending database. If the message is already transmitted to the wireless communication device in step (d), the step (e), storing messages to be transmitted to wireless communication devices in a pending database must be before step (d).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2683

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-3,6-9,11-13,19-21 and 25 are rejected under 35

U.S.C. 103(a) as being unpatentable over O'Neil in view of

Deluca et al..

Regarding claims 1 and 2, O'Neil discloses a method (fig.7, fig.8 and fig. 9) for transmitting a message over a wireless network to a wireless communications device (paragraph 0003 line 1 through paragraph 0005 line 6), said method comprising the steps of: (a) storing a plurality of messages (advertisements or merchant data) in a database (paragraph 0027 lines 1-17), wherein each stored message is associated with one or more locations paragraph 0027 lines 1-17; (b) detecting location information of a wireless communications device (paragraph 0041 line 1 through paragraph 0043 line 12); (c) selecting a message in the database associated with the detected location (paragraph 0043 lines 1-12); (d) transmitting the selected message to the wireless communications device (paragraph 0047 lines 1-32), storing the advertisement to be transmitted to the wireless communications device in a pending database (selected merchant database, the advertisement is sent when a customer travels near a select merchant) (paragraph 0046 and paragraph 0047); transmitting the advertisement stored in a pending database over a forward control channel to the wireless device (i.e. the advertisement transmits the associated advertisement to the user) (paragraph 0047).

O'Neil differs from claim 19 of the present invention in that it does not disclose receiving an acknowledgement from the wireless communications device of receipt of the selected advertisement over a reverse control channel. Deluca et al. teaches a system controller that receives an acknowledgement from a selective call transceiver of receipt of an advertisement over a reverse control channel (col. 10 lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide O'Neil with receiving an acknowledgement from the wireless communications device of receipt of the selected advertisement over a reverse control channel in order for the advertisement server to acknowledge

Art Unit: 2683

that the mobile IP terminal receive its advertisement so that the advertisement server could modify the mobile IP terminal profile based upon the mobile IP terminal preferred advertisement and properly billed the merchant of the advertisement, as taught by Deluca et al..

Regarding claim 3, O'Neil discloses each of the plurality of messages stored in the database contains advertising information sponsored by a respective advertiser having a place of business within a proximity of the location associated with the message (paragraph 0027 line 1 through paragraph 0028 line 4).

Regarding claim 6, O'Neil discloses paper media (text) and voice mail (audio information).

Regarding claim 7, O'Neil discloses the wireless communications device is a cell phone (paragraph 0039 lines 1-10) and a automotive navigational system (paragraph 0058 lines 1-6).

Regarding claim 8, O'Neil discloses each of the messages stored in the database is also associated with one or more demographic codes (merchant ID, name, location, IP address etc.) (fig. 3 number 250), each wireless communications device operating in the wireless network is associated with one more demographic codes (fig. 3 numbers 230, 250 and 270 and paragraph 0034 lines 1-24 and paragraph 0037 lines 1-10), and wherein the message selected to be transmitted is associated with at least one demographic code associated with the identified wireless communications device in addition to being associated with the detected location (paragraph 0034 lines 1-24 and paragraph 0037 lines 1-10 and paragraph 0046 lines 1-32).

Regarding claim 9, O'Neil discloses a method (fig. 7, fig. 8, fig. 9) for transmitting an advertisement over a wireless network to a wireless communications device (paragraph 0003 through paragraph line 6), said method comprising the steps of: (a) storing a plurality of advertisements in an advertisements database (paragraph 0027 lines 1-17), wherein each advertisement is requested to be transmitted to wireless communications devices by a respective advertiser (paragraph 0027 line 1 through paragraph 0028 line 4), and each advertisement is associated with one or more locations (paragraph 0028 line 4) and category codes (key words); (b) storing information pertaining to a plurality of wireless communications devices in a devices database (paragraph

Art Unit: 2683

0032 lines 1-14), wherein each wireless communications device is associated with identification data (paragraph 0032 lines 1-14) and category codes (preferences) (paragraph 0032 lines 1-14); (c) storing in an advertisers database a list of advertisers requesting transmission of advertisements stored in the advertisements database (paragraph 0034 lines 1-24), wherein each advertiser is associated with advertiser account information (willing to pay) (paragraph 0038 lines 4-5); (d) detecting the presence of the wireless communications device in a location (paragraph 0041 line 1 through paragraph 0043 line 12); (e) detecting an identification of the wireless communications device (paragraph 0041 line 1 through paragraph 0043 line 12); (f) selecting an advertisement in the database associated with the detected location and associated with at least one category code (preference) associated with the wireless communications device in the devices database (paragraph 0047 lines 1-32); and (g) transmitting the selected advertisement to the wireless communications device over a forward channel (paragraph 0047 lines 1-32). O'Neil differs from claim 9 of the present invention in that it does not disclose receiving an acknowledgement from the wireless communications device of receipt of the selected advertisement over a reverse control channel. Deluca et al. teaches a system controller that receives an acknowledgement from a selective call transceiver of receipt of an advertisement over a reverse control channel (col. 10 lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide O'Neil with receiving an acknowledgement from the wireless communications device of receipt of the selected advertisement over a reverse control channel in order for the mobile IP terminal to inform the advertisement server that it receive the advertisement so that the advertisement server could modify the mobile IP terminal profile preference based upon the mobile IP terminal preferred advertisement, as taught by Deluca et al..

Regarding claim 11, O'Neil discloses wherein advertisers access the advertisers database to add requests to transmit advertisements through an Internet web page (paragraph 0038 lines 1-13).

Regarding claim 12, O'Neil discloses wherein users of wireless communications devices access the devices database to select from one or more category codes that correspond to the users' preferences for receiving advertisements (user specifies a delivery preference) (paragraph lines 13-15).

Art Unit: 2683

Regarding claim 13, O'Neil discloses the advertisements database is automatically created from requests to transmit advertisements stored in the advertisers database (paragraph 0034 lines 1-20).

Regarding claim 19, O'Neil discloses a method (fig. 7, fig. 8, and fig. 9) for transmitting advertisements over a wireless network to wireless communications devices (paragraph 0003 through paragraph line 6), the wireless network in communication with an advertisements database containing a plurality of advertisements (paragraph 0027 lines 1-17 and paragraph 0034 lines 1-24) and a users database (paragraph 0032 lines 1-14) containing identification data of a plurality of wireless communications devices (paragraph 0032 lines 1-14), and wherein the advertisements and the identification data are each associated with at least one category code (preference) (paragraph 0032 lines 1-14), said method comprising the steps of:

- (a) detecting identification information of a wireless communications device operating in the wireless network (paragraph 0041 line 1 through paragraph 0043 line 12);
- (b) selecting an advertisement in the database associated with at least one category code (preference) that is associated with the wireless communications device in the users database (paragraph 0047 lines 1-32); storing the advertisement to be transmitted to the wireless communications device in a pending database (selected merchant database, the advertisement is sent when a customer travels near a select merchant) (paragraph 0046 and paragraph 0047); transmitting the advertisement stored in a pending database over a forward control channel to the wireless device (i.e. the advertisement transmits the associated advertisement to the user) (paragraph 0047).

O'Neil differs from claim 19 of the present invention in that it does not disclose receiving an acknowledgement from the wireless communications device of receipt of the selected advertisement over a reverse control channel. Deluca et al. teaches a system controller that receives an acknowledgement from a selective call transceiver of receipt of an advertisement over a reverse control channel (col. 10 lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide O'Neil with receiving an acknowledgement from the wireless communications device of receipt of the selected advertisement over a reverse control channel in order for the advertisement server to acknowledge that the mobile IP terminal receive its advertisement so that the advertisement server could

Art Unit: 2683

modify the mobile IP terminal profile based upon the mobile IP terminal preferred advertisement, and properly billed the merchant of the advertisement, as taught by Deluca et al..

Regarding claim 20, O'Neil discloses the category code indicates a category (delivery preference) pertaining to a service associated with a respective advertisement (paragraph 0047 lines 1-32).

Regarding claim 21, O'Neil discloses wherein the category codes associated with wireless communications devices indicates users' preferences in receiving advertisements (i.e. delivery preference) (paragraph 0047 lines 1-32).

Regarding claim 25, O'Neil discloses the wireless communications device is operating on the wireless network in a cell location that is associated with the selected advertisement (inherent, when a cell phone is in communication with an advertisement server, as taught in paragraph 0039 lines 1-8).

7. Claims 14, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Deluca et al. as applied to claims 9 and 19 above and in further view of Mankoff.

Regarding claim 14, the combination of O'Neil and Deluca et al. differs from claim 14 of the present invention in that they do not disclose wherein the advertisements contain coupons to be redeemed with the respective advertiser. Mankoff teaches advertisements contain coupons to be redeemed with respective advertiser (paragraph 0008 lines 1-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of O'Neil and Deluca et al. with coupons to be redeemed with the respective advertiser in order for the cell phone to receive a discount when purchasing goods from a nearby merchant, as taught by Mankoff.

Regarding claims 23 and 24, the combination of O'Neil and Deluca et al. differs from claims 23 and 24 of the present invention in that they do not disclose transmitting coupons over a wireless network to a wireless communication device, a database for storing a plurality of coupons associated with advertisers; receiving response information from the wireless communications

Art Unit: 2683

device; and providing response information to the advertiser. Mankoff teaches transmitting coupons over a wireless network to a wireless communication device (paragraph 0008 lines 1-26), a database for storing a plurality of coupons associated with advertisers (paragraph 0024 lines 1-22); receiving response information (coupon redeemed) from the wireless communications device (paragraph 0008 lines 1-26); and providing response information (coupon redeemed) to the advertiser (paragraph 0008 lines 1-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To modify the combination of O'Neil and Deluca et al. with transmitting coupons over a wireless network to a wireless communication device, a database for storing a plurality of coupons associated with advertisers; receiving response information from the wireless communications device; and providing response information to the advertiser in order for the user of the IP terminal receive discounts on select merchandise from nearby merchants, to provide discount coupons to travelers in proximity of the merchants, and redeemed the coupon for a cheaper price at a nearby restaurant, as taught by Mankoff.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Mankoff and Deluca et al..

Regarding claim 26, O'Neil discloses a method (fig. 7, fig. 8, and fig. 9) for transmitting advertisements over a wireless network to wireless communications devices (paragraph 0003 through paragraph line 6), the wireless network in communication with an advertisements database containing a plurality of advertisements (paragraph 0027 lines 1-17 and paragraph 0034 lines 1-24) and a users database (paragraph 0032 lines 1-14) containing identification data of a plurality of wireless communications devices (paragraph 0032 lines 1-14; said method comprising the steps of: detecting identification information of a wireless communications device operating in the wireless network (paragraph 0041 line 1 through paragraph 0043 line 12); storing the advertisement to be transmitted to the wireless communications device in a pending database (selected merchant database, the advertisement is sent when a customer travels near a select merchant) (paragraph 0046 and paragraph 0047); and transmitting the selected advertisement to the wireless communications device (paragraph 0047 lines 1-32). O'Neil differs from claim 26 of the present invention in that it does not explicit disclose storing advertisement coupons;

Art Unit: 2683

transmitting coupons over a wireless network to a wireless communication device over a forward channel, receiving an acknowledgement from the wireless communication device of receipt of the transmitted advertisement coupon over a reverse control channel. Mankoff teaches transmitting coupons over a wireless network to a wireless communication device over a forward channel (paragraph 0008 lines 1-26), a database for storing a plurality of coupons associated with advertisers (paragraph 0024 lines 1-22). Deluca et al. teaches a system controller that receives an acknowledgement from a selective call transceiver of receipt of an advertisement over a reverse control channel (col. 10 lines 1-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To modify O'neil wireless network with storing advertisement coupons; transmitting coupons over a wireless network to a wireless communication device over a forward channel, receiving an acknowledgement from the wireless communication device of receipt of the transmitted advertisement coupon over a reverse control channel in order for the advertisement server to store advertisement coupon from merchants, to provide discount coupons to travelers in proximity of the merchants, and receive acknowledgement from the IP terminal that it received the coupon so that the advertisement server could properly bill the merchant, as taught by Mankoff and Deluca et al..

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Hendrey et al..

Regarding claim 4, O'Neil discloses a method as discussed supra in claims 1 and 2 above. O'Neil differs from claim 4 of the present invention in that it does not disclose the wireless communications device is associated in the database with a field indicating whether to block the transmission of messages to the wireless communications device, whereby messages that are associated in the database with a field indicating to block the transmission of messages are not transmitted to the wireless communications devices. Hendrey et al. teaches the wireless communications device is associated in the database with a field indicating whether to block the transmission of messages to the wireless communications device (paragraph 0037 lines 8-13), whereby messages that are associated in the database with a field indicating to block the transmission of messages are not transmitted to the wireless communications devices (paragraph

Art Unit: 2683

0037 lines 8-13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify O'Neil method with the wireless communications device is associated in the database with a field indicating whether to block the transmission of messages to the wireless communications device, whereby messages that are associated in the database with a field indicating to block the transmission of messages are not transmitted to the wireless communications devices in order to prevent advertisements from merchants during dinner time, as taught by Hendrey et al..

10. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Deluca et al. as applied to claim 19 above and in further view of Hendrey et al..

Regarding claim 22, the combination of O'Neil and Deluca et al. differs from claim 22 of the present invention in that they do not disclose the wireless the category code indicates a category pertaining to a time period, wherein different advertisers prefer to have advertisements transmitted during different particular time periods, and wherein different users prefer to have advertisements transmitted during different particular time periods. Hendrey et al.. teaches a category code indicates a category pertaining to a time period (paragraph 0032 lines 1-21), wherein different advertisers prefer to have advertisements transmitted during different particular time periods (paragraph 0032 lines 1-21), and wherein different users prefer to have advertisements transmitted during different particular time periods (paragraph 0032 lines 1-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of O'Neil and Deluca et al. with the wireless the category code indicates a category pertaining to a time period, wherein different advertisers prefer to have advertisements transmitted during different particular time periods, and wherein different users prefer to have advertisements transmitted during different particular time periods in order to tailor the merchant advertisement based upon the time period that the IP terminal would respond, and not waste advertisement resources by continuing sending advertisements, as taught by Hendrey et al..

Art Unit: 2683

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil in view of Deluca et al. as applied to claim 9 above and in further view of Wolfe et al..

Regarding claim 10, the combination of O'Neil and Deluca et al. differs from claim 10 of the present invention in that they not disclose updating the advertiser account information of the advertiser requesting transmission of the selected advertisement. Wolfe et al. teaches updating the advertiser account information of the advertiser requesting transmission of the selected advertisement (col. 4 lines 47-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of O'Neil and Deluca et al. with updating the advertiser account information of the advertiser requesting transmission of the selected advertisement in order to bill the merchant for new advertisements being sent to the IP terminal, as taught by Wolfe et al..

Allowable Subject Matter

3. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 5, the prior art of record fails to teach or suggest, alone or in combination the steps of: deleting the transmitted message from the pending database; and storing a confirmation of the transmitted message

Art Unit: 2683

in an account associated with the respective advertiser sponsoring the message.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T.

Art Unit: 2683

Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith Ferguson
Art Unit 2683
October 20, 2004




WILLIAM TROST
SUPERVISORY PATENT EXAMINER
BIOLOGY CENTER 2600